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EXAMINER

SHAW, JOSEPH D

ART UNIT PAPER NUMBER

2141

DATE MAILED: 04/05/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

12

**Office Action Summary**

Application No.

09/729,810

Applicant(s)

SHAO ET AL.

Examiner

Joseph D Shaw

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/4/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 15-33 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-19, 21-33 and 36-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 15, 20, 35 and 40-42 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: claims 1, 2-8, 9-13, 16-19, 21, 22-28, 29-33, and 36-39.

Species 2: claims 1, 9-13, 15, 16-19, 21, 29-33, 35, and 36-39.

Species 3: claims 1, 9-13, 16-19, 20, 21, 29-33, 36-39, and 40.

Species 4: claims 1, 9-13, 16-19, 21, 29-33, 36-39, 41, and 42.

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, species 1-4 have independent claims 1 and 21 as generic claims.

3. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

4. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with Mr. Brian D. Hickman on March 26<sup>th</sup>, 2004 a provisional election was made with traverse to prosecute the invention of species 1, claims 1, 2-8, 9-13, 16-19, 21, 22-28, 29-33, and 36-39. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15, 20, 35, and 40-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Specification***

7. The disclosure is objected to because of the following informalities:

- a. On page 8, line 17, the word "be" should be inserted between "may" and "an."

Appropriate correction is required.

#### ***Claim Objections***

8. Claims 3, 10, 23, and 30 are objected to because of the following informalities:

- b. On line 5 of claims 3 and 23, the word "that" should be inserted between "records" and "are."

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c. On line 2 of claims 10 and 30, "interfaces" should be replaced with "interface."

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 10, 12-13, 21, 30, and 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Young et al. (US 2002/0065774).

d. As per claims 1 and 21, Young teaches:

storing, external to a device and separate from a first service of a plurality of services, data records containing a plurality of data items associated with a particular type of information (external electronic wallet stores payment data related to a user, containing multiple shipping addresses and payment options; Fig. 1; pages 3-4, paragraph 0035; page 6, paragraph 0057);

receiving a first message from said device requesting said first service, wherein said first service requires said particular type of information for input (portal receives a customers decision to purchase

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a product and requires payment and shipping information; page 1, paragraph 0008; page 6, paragraphs 0055-0058);

reading said data records and transmitting data to said device to cause said device to present a user interface a particular data item of said plurality of data items to be selected (the wallet may contain multiple, alternative shipping addresses and the user may chose from one of those addresses; the wallet may contain information related to various payment options, and the user may chose from any one of the shown options; page 6, paragraph 0057);

receiving a second message indicating a selection from said device of said particular data item (portal receives the shipping detail data and payment option data reflecting the desired means of payment (page 6, paragraph 0060); and

sending said particular data item to said first service of said plurality of services (shipping address and payment option is transmitted to the merchant of the product desired; pages 6-7, paragraph 0061).

e. As per claims 10 and 30, Young discloses the invention described above and furthermore teaches:

the step of transmitting data to said device to cause said device to present a user interface including transmitting data to said device to cause said device to present a user interface that displays a first subset of said plurality of data items (user chooses from a plurality of addresses; page 6, paragraph 0057).

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f. As per claims 12 and 32, Young discloses the invention described above and furthermore teaches:

said particular data item identifying a particular address (user specifies shipping address from the wallet; page 6, paragraph 0057).

g. As per claims 13 and 33, Young discloses the invention described above and furthermore teaches:

said data records being stored in a database with data that associates the data records with an identifier (user supplies a user name and password, the wallet access a database to retrieve payment method; page , paragraph 0039; lines 17-25); and

extracting the identifier from said first message and locating said data records based on said identifier (inherent that the database accessed is associated with the user id and the user id is contained in message from the device).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 4-5, 9, 22, 24-25, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US 2002/0065774) in view of Light et al. (6,192,380).

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h. As per claims 2 and 22, Young discloses the invention described above. However, Young does not explicitly teach receiving content provided by the plurality of services, identifying data items in the content associated with the particular information, and storing data records containing the items. Light teaches:

receiving content provided by said plurality of services (receives a web page containing a form with multiple selectable values; col. 2, line 53 - col. 3, line 18);

identifying, within said content, data items associated with said particular type of information (user completes the form, adds new data if necessary; col. 4, lines 15-24; col. 6, line 43 - col. 7, line 19); and

storing data records containing said data items (user is queried if new data should be added to the database; col. 7, lines 11-17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have the remote electronic wallet taught by Young include the features of receiving content provided by the plurality of services, identifying data items in the content associated with the particular information, and storing data records containing the items, as taught by Light, because Young's remote electronic wallet would then be able to learn new information each time it is encountered in a form, as taught by Light (col. 6, line 43 - col. 7, line 19), alleviating the burden and possibility of making mistakes that are common with having to re-enter form data over and over again, as taught by Light (col. 1, lines 28-40).



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i. As per claims 4 and 24, Young discloses the invention modified by Light as described above. Furthermore, Light teaches:

the step of storing data records containing said data items is performed transparent to a user of said device (tags and data are automatically entered into the database; col. 7, lines 17-19).

j. As per claims 5 and 25, Young discloses the invention modified by Light as described above. However, the modified Young invention does not explicitly teach deleting data records in response to storing data records when an amount associated with the data records has reached a predetermined threshold. "Official Notice" is taken that both the concept and advantages of deleting data to make room for new data is well known and expected in the art.

It would have been obvious to modify the modified Young invention to include deleting data records to make room for new data records when a threshold has been met because it is not possible to store an infinite amount of data, so limits exist on data storage, requiring some data to be replaced with new data when limits are reached.

k. As per claims 9 and 29, Young discloses the invention modified by Light as described above. Furthermore, Light teaches:

the content including tags (col. 3, lines 19-47); and

the steps of identifying, within said content, data items associated with said particular information is performed based on said tags (the learning subunit scans the form and extracts tags and data; page 4, lines 15-30).

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13. Claims 3 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US 2002/0065774), in view of Light et al. (6,192,380) as applied to claims 2 and 22, and further in view of Klug et al. (2001/0011274).

1. As per claims 3 and 23, Young discloses the invention modified above. However, the modified Young invention does not explicitly teach receiving content requested in messages, containing identifiers, from the device and storing data records that are associated with the identifier. Klug teaches:

receiving content requested in messages from the device (user desires to register at a third-party site; pages 4-5, paragraph 0034);

said message containing a particular identifier (user supplies a user ID to gain access; page 5, paragraph 0034, lines 4-7); and

storing data records that are associated with said particular identifier (storing the different user ID for the third-party site in the original user ID's profile; page 7, paragraphs 0050-0051).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include an identifier within a message to request data and storing data records associated with that identifier, as taught by Klug, in the modified Young invention because the users now have the convenience of off-site storage backup for each service and it may even be easier for the service to retrieve the site specific ID from the central database, as taught by Klug (page 7, paragraph 0051).

14. Claims 6-8 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US 2002/0065774) in view of Light et al.

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(6,192,380), as applied to claims 5 and 25, and further in view of Patterson et al. (Computer Organization and Design: The Hardware/Software Interface).

m. As per claims 6-7 and 26-27, Young discloses the invention modified above. However, the modified Young invention does not explicitly teach:

selecting data records to delete based on a sequence associated with said existing data records; and

wherein said sequence reflects when data items within said existing data records were most recently selected.

Patterson teaches that devices of limited storage capability (caches) can implement a least recently used (LRU) algorithm for determining what data to replace, wherein the data replaced is the data that has gone unused for the longest time (pages 575-576, Choosing Which Block to Replace).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have Patterson's LRU data replacement algorithm determine which data to be replaced in the modified Young invention because the LRU is a commonly used data replacement scheme, as taught by Patterson (page 575, line 1) and allows for current data to remain stored at the expense of obsolete data.

n. As per claims 8 and 28, Young discloses the invention modified above in claims 6 and 26. However, the Patterson modification only implements a LRU replacement algorithm, and does not replace data based on when the data was generated. "Official Notice" is taken that both the concept and advantages of having data replacement algorithms based on when data was generated are well known and expected in the art.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have the modified Young's scheme for replacing data be based on when data was generated because this would allow any programmer or architect to implement the very common and easy to design first-in-first-out (FIFO) stack or queue to hold the data records.

15. Claims 11, 16, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US 2002/0065774).

o. As per claims 11 and 31, Young discloses the invention described above in claims 1 and 21. However, Young does not explicitly teach causing the device to present an option to have the list be updated to display a second subset of said plurality of data times. "Official Notice" is taken that both the concept and advantages of having an option to display a second subset of a plurality of data items (allowing an option to scroll through a list of data) is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Young invention to include an option to have the list be updated to display a second subset of said plurality of data times because a user of the Young invention would now be able to scroll through and view a plurality of data if the entire list of that data did not fit onto the screen of the user.

p. As per claims 16 and 36, Young discloses the invention described above in claims 1 and 21. However, Young does not explicitly teach deleting data records in response to storing data records when an

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amount associated with the data records has reached a predetermined threshold. "Official Notice" is taken that both the concept and advantages of deleting data to make room for new data is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Young invention to include deleting data records to make room for new data records when a threshold has been met because it is not possible to store an infinite amount of data, so limits exist on data storage, requiring some data to be replaced with new data when limits are reached.

16. Claims 17-19 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US 2002/0065774) in view of Patterson et al. (Computer Organization and Design: The Hardware/Software Interface).

q. As per claims 17-18 and 37-38, Young discloses the invention modified above in claims 16 and 26. However, the modified Young invention does not explicitly teach:

selecting data records to delete based on a sequence associated with said existing data records; and

wherein said sequence reflects when data items within said existing data records were most recently selected.

Patterson teaches that devices of limited storage capability (caches) can implement a least recently used (LRU) algorithm for determining what data to replace, wherein the data replaced is the data that has gone unused for the longest time (pages 575-576, Choosing Which Block to Replace).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have Patterson's LRU data replacement algorithm determine which data to be replaced in the modified Young invention because the LRU is a commonly used data replacement scheme, as taught by Patterson (page 575, line 1) and allows for current data to remain stored at the expense of obsolete data.

r. As per claims 19 and 39, Young discloses the invention modified in claims 17 and 37. However, the Patterson modification only implements a LRU replacement algorithm, and does not replace data based on when the data was generated. "Official Notice" is taken that both the concept and advantages of having data replacement algorithms based on when data was generated are well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have the modified Young's scheme for replacing data be based on when data was generated because this would allow any programmer or architect to implement the very common and easy to design first-in-first-out (FIFO) stack or queue to hold the data records.

#### **Conclusion**

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D Shaw whose telephone number is 703-305-0094. The examiner can normally be reached on Monday - Thursday and alternate Fridays, 7am - 4pm.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharra can be reached on 703-305-4003. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph Shaw  
Examiner  
AU 2141

  
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